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David W. Highet, VP & Chief IP Counsel Becton, Dickinson and Company (The Webb Firm) 1 Becton Drive, MC 110 Franklin Lakes, NJ 07414-1880			MATTER, KRISTEN CLARETTE	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MICHAEL J. ISKRA

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Appeal 2012-006903  
Application 08/928,272  
Technology Center 3700

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Before STEFAN STAICOVICI, JAMES P. CALVE, and  
LYNNE H. BROWNE, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Michael J. Iskra (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision finally rejecting under 35 U.S.C. § 103(a) claims 1, 6, and 9 as unpatentable over Appellant's Admitted Prior Art (Figures 1 and 2 of Appellant's Drawings)<sup>1</sup> and Finney (US 4,358,425, iss. Nov. 9, 1982) and claims 5, 7, and 8 as unpatentable over AAPA, Finney, and Burns (US 5,458,854, iss. Oct. 17, 1995). Claims 2-4 and 10-20 have been canceled. Appellant's representative presented oral argument on Nov. 9, 2012. We have jurisdiction over this appeal under 35 U.S.C. § 6.<sup>2</sup>

## THE INVENTION

Appellant's invention relates to a "collection container for collecting fluid specimens," including an annular skirt 78, a closed bottom end 76, and a rounded open bottom end 80 that defines an open false bottom area 82. Spec. 1, l. 15; Spec. 8, ll. 18-21; and fig. 4.

Claim 1, the sole independent claim, is representative of the claimed invention and reads as follows:

1. A one piece collection container assembly comprising:  
an elongate tubular housing having a sidewall extending between opposed first and second ends; and  
a solid partition in contact with said sidewall, positioned within said housing between

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<sup>1</sup> Hereafter referred to as "AAPA." See Spec. 7, ll. 7-10.

<sup>2</sup> This is Appellant's second appeal before the Patent Trial and Appeal Board. In the first appeal (2005-2410, Decision mailed September 19, 2005) (hereafter "Decision"), the Examiner's decision to reject claims 1, 5, 7, and 8 under 35 U.S.C. § 102(b) as anticipated by Burns and claims 6 and 9 under 35 U.S.C. § 103(a) as unpatentable over Burns was affirmed.

said first and second ends, forming a closed bottom;

said housing defining a volume for specimen collection and containment therein between said first end and said partition;

said second end forming a false bottom comprising a bottom end below said partition, said bottom end comprising an annular skirt and a semi-spherical bottom, wherein said semi-spherical bottom comprises an opening therein.

### SUMMARY OF DECISION

We AFFIRM.

### ANALYSIS

#### *Claims 1, 6, and 9*

The Examiner found that “[t]he sole difference between the admitted prior art and the instant invention is the bottom of the tube being semi-spherical.” Ans. 5. However, according to the Examiner, “absent a critical teaching and/or showing of unexpected results . . . such a modification is an obvious design consideration to one of ordinary skill in the art as a mere change in shape does not patentably distinguish an invention over the prior art.” *Id.* Nonetheless, the Examiner further found that Finney teaches a specimen collection tube with a semi-spherical bottom surface. *Id.* Thus, the Examiner concluded that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the admitted prior art device with a semi-spherical false bottom as taught by Finney depending on the intended use of the device or to allow compatibility with standard clinical centrifuge equipment.” Ans. 5-6.

Appellant argues that in contrast to the Examiner's position, changing the shape of AAPA's bottom to be semi-spherical is critical because it allows the AAPA collection tube "to be compatible with standard clinical equipment specifically designed to handle standard-sized blood tube configurations having a rounded bottom, such as storage racks, chemical analyzers, and centrifuges." Reply Br. 2. *See also*, Ans. 5. Moreover, Appellant takes the position that there is nothing in the Abstract of Finney "that suggests, let alone teaches, that the shape of the bottom of the tube is what allows the tube to be useful in the cavity of a centrifuge rotor." App. Br. 13. Thus, according to Appellant, the "Examiner's conclusion that a tube with a rounded bottom allows for compatibility with a clinical equipment appears to be based not on Finney, but rather on the specification of the subject application itself." App. Br. 14.

We are not persuaded by Appellant's arguments for the following reasons. AAPA and the claimed invention are both directed to specimen collection tubes having a false bottom. *See* Spec. 8, ll. 4-22 and Figures 1 and 3 of Appellant's Drawings. The difference between AAPA and the claimed invention is that the bottom of the AAPA tube is flat, while the claimed collection container has a semi-spherical bottom. *Id.* Finney specifically teaches a tube "for use in the cavity of the rotor of a high speed centrifuge" having "a rounded bottom with an opening." Finney, Abstract. Thus, Finney gives a person of ordinary skill in the art a clear indication that a centrifuge specimen collection tube includes a semi-spherical bottom as the Examiner found. *See* Ans. 9 (citing Abstract). Furthermore, we agree with the Examiner that both flat-shaped bottom collection tubes and semi-spherical shaped bottom collection tubes are usable with centrifuges. Ans.

8. *See e.g.*, App. Br. 13<sup>3</sup> and Finney, Abstract. As such, since both shapes are usable with a centrifuge, we agree with the Examiner that “changing the shape of the admitted prior art is *not gaining any critical advantage*.” Ans. 8. *See In re Dailey*, 357 F.2d 669 (CCPA 1966). *See also, In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975) (use of claimed feature solves no stated problem and presents no unexpected result and “would be an obvious matter of design choice within the skill of the art” (citing *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and *In re Gazda*, 219 F. 2d 449 (1955))). Therefore, we agree with the Examiner that modifying the flat bottom end of AAPA’s collection tube to include a semi-spherical bottom end as taught by Finney “would involve substitution of a well[-]known shape (i.e., tube having a semi-spherical bottom) into a well[-]known device to yield predictable results that do not patentably distinguish an invention over the prior art and would have been obvious to try from a finite number of standard centrifuge tube bottom shapes compatible with clinical equipment.” Ans. 6. “When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Since both flat-shaped bottom tubes and semi-spherical shaped bottom tubes are usable with centrifuges, it appears that a semi-spherical bottom collection tube would function in a similar manner as the flat-bottom collection tube of

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<sup>3</sup> “. . . the preferable use of the container in the Burns patent . . . which does not have a rounded bottom, is in a micro-centrifuge (Burns, col. 2, lines 43-44) or, with the aid of a flat-bottomed extension, in a normal centrifuge (Burns, col. 5, lines 13-17).”

AAPA. “If [pursuing known options] leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.” *See Id.* at 421.

Lastly, Appellant argues that Finney fails to teach a “false bottom” (*see* App. Br. 14) and a “semi-spherical bottom with an opening therein” (*see* App. Br. 15). We are not persuaded by Appellant’s arguments because nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here, the Examiner found that AAPA discloses a false bottom 32 including an annular skirt 28 having an opening 36 therein. Ans. 5. The Examiner used the teachings of Finney to merely show that it is known to provide a centrifuge tube with a semi-spherical bottom. *Id.* *See also*, Finney, Abstract and fig. 1.

In conclusion, for the foregoing reasons, the rejection of independent claim 1 under 35 U.S.C. § 103(a) as unpatentable over AAPA and Finney is sustained. Since Appellant does not set forth any other arguments with respect to the rejection of dependent claims 6 and 9, we shall also sustain the rejection of these claims. *See* App. Br. 15.

#### *Claims 5, 7, and 8*

Pointing to column 5, lines 7-12 of Burns, Appellant argues that, “Burns teaches away from claim 1 by specifically requiring that the bottom end of the tube includes a cylindrical shape for receiving a portion of the cap thereon. App. Br. 16.

This argument does not address the Examiner's proposed combination. The Examiner is not proposing to include the flat-bottom end 47 of Burns in the collection tube of AAPA and Finney, as Appellant argues. Rather, the Examiner is proposing to modify the conical closed bottom end 26 of the collection tube of AAPA and Finney to include the arcuate shaped partition 38 of Burns. Ans. 7. *See also*, Burns, fig. 1. Obviousness does not require that all of the features of the secondary reference be bodily incorporated into the primary reference *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Thus, for the foregoing reasons, we shall also sustain the rejection of claims 5, 7, and 8 over the combined teachings of AAPA, Finney, and Burns.

#### SUMMARY

The Examiner's decision to reject claims 1 and 5-9 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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